

## REMARKS/ARGUMENTS

Claims 1-51 are pending in the present application and remain in this application for prosecution. Although none of the claims has been amended, a listing of the claims has been included for the convenience of the Examiner.

### **I. § 112 Rejections**

Claims 1 -51 have been rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. Furthermore, claims 1-51 have been rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the enablement requirement.

The office action provides a series of conclusive reasons in an attempt to support the rejections regarding the claim term “a universal personal identifier object (UPI object) in a form of a tangible object whose primary purpose is not directed to identifying the patron at a particular game venue. None of these reasons is supported by citations to any evidence or to specific authority (*e.g.*, patent rules, patent laws, court decisions, *etc.*).

Furthermore, the reasons do not specifically state which reasons are related to which rejections. In other words, the office action generically alleges both written description requirement rejections and enablement rejections, but fails to clearly identify the reasons that are specifically applicable to a respective rejection. The Applicants cannot properly address the rejection reasons because the rejections are vague and ambiguous.

Moreover, as respectfully explained in more detail below, the logic of the reasons is flawed as it appears to ignore commonly accepted patent rules and, also, common understanding of term meanings.

**A. Written Description Requirement**

“To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.” Manual of Patent Examining Procedure (“MPEP”), Eighth Ed., Rev. 6, Sept. 2007, § 2163(I), p. 2100-172 (right col.); *see, e.g., Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 U.S.P.Q. 2d 1429, 1438 (Fed. Cir. 2003). As such, “the ‘essential goal’ of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed.” *Id.* at p. 2100-172 (left col.), citing *In re Barker*, 559 F.2d 588, 592 n. 4, 194 U.S.P.Q. 470, 473 n. 4 (C.C.P.A. 1977). Furthermore, the “examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims.” *Id.*, § 2163(II), p. 2100-176 (emphasis added).

One of ordinary skill in the art would recognize that the written description of the invention provides support for the claims. For example, the specification describes a number of exemplary “tangible objects” whose primary purposes is not directed to identifying the patron at a particular game venue. Such exemplary “tangible objects” include a driver’s license and a credit card. Current specification, ¶¶ 0017-0018, 0028. The main purpose of the driver’s license is directed to driving privileges, *i.e.*, driving a car on the street – it is not directed to identifying the patron at a game venue. Moreover, the specification also describes that “the patron can be readily identified without having previously registered using the more formal registration procedure.” Current specification, ¶ 0020.

The rejection appears to ignore the requirement for a “thorough reading and evaluation of the content of the application.” As stated above, the specification, provides ample support for the rejected claim element.

The rejection also appears to ignore the “person of skilled in the art” standard. From the above examples, it should be clear that one of skill in the art would understand what is meant by the rejected claim term. In fact, it is respectfully suggested that even a person that is not of ordinary skill in the art would likely understand what is meant by the rejected claim term. It is commonly accepted that a person may apply and receive a driver’s license for the main purpose of driving. The person will generally not apply for the driver’s license so that they can conduct wagering sessions at casino establishments. As such, it is quite clear what is meant by a tangible object (*e.g.*, a driver’s license card) having a primary purpose that is not directed to identifying the patron at a game venue (*e.g.*, the primary purpose is directed to driving privileges).

### ***B. Enablement Requirement***

To make an enablement rejection, “the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.” MPEP, § 2164.04, p. 2100-198 (left col.) (emphasis added). Similar to the written description requirement, the standard for enablement is based on the skill of “persons skilled in the art.” *Id.*, § 2164.05(b), p. 2100-198 (left col.).

As noted earlier, it is unclear what specific reasons the office action is relying on for alleging that the rejected claim term is not enabled. At least based on the credit card and/or driver’s license examples, the Applicants respectfully submit that the specification clearly provides more than sufficient disclosure for enabling to one of ordinary skill in the art to make

and use the claimed UPI object. Furthermore, the specification (which the MPEP requires that it be thoroughly evaluated by the Examiner) discloses in detail a gaming network 12 that can be used in conjunction with the claimed tangible object.

### ***C. Rejection Reasons Fail To Support The Rejections***

- 1. The term “universal personal identifier object” does NOT contradict the phrase “whose primary purpose is not directed to identifying the patron at a particular game venue”*

The office action remarks that the “universal personal identifier object” (“UPI object”) “should be used to identify a patron regardless of where the person is located” if the UPI object is “universally used to identify a patron.” Based on this logic, the office action concludes that the term UPI object contracts the phrase “whose primary purpose is not directed to identifying the patron at a particular game venue.” This (unsupported) logic is clearly flawed.

One problem with this remark is that the office action appears to assume that the term “universal” necessarily requires that every purpose of the UPI object is a primary “purpose.” However, the “universal” personal identifier object can have a “universal” aspect (as referred to in the specification), which is generally directed to its primary purpose, and also have another purpose (*e.g.*, secondary purpose).

Referring for example purposes to a driver’s license, the driver’s license is “universal” in the sense that it may be accepted in more than one geographical location. The driver’s license holder is generally permitted to drive virtually anywhere in the United States (as well as many foreign countries). Thus, it is “universal.” However, the driver’s license has not been disclosed to serve (before this application) as an identification object at a gaming venue.

It is simply not clear why the office action asserts that this claim term is contradictory. Maybe, the office action is inferring that the term “universal” means “everything” and “everywhere.” This would be, however, an exaggerated interpretation of the term “universal.” In a related example, it is generally accepted that an “international” company conducts business in at least two different countries. The “international” term does not suggest that the company conducts business in every country or that every business transaction is an international transaction. Similarly, the term “universal” (as used in the context of the current specification) does not suggest that every purpose is a primary purpose. Instead, the “universal” aspect of the UPI object is simply generally directed to being accepted in a plurality of places just like a driver’s license or a credit card are intended for acceptance in a plurality of places.

## *2. The Meaning Of The Claim Term Is Clear*

The office action alleges that it “is not clear how an object can universally be used to identify a person, but not be primarily be used to identify the patron at a particular game venue.” In view of the above explanation, it should be clear how the claim term is clear. The driver’s license example shows how a drivers’ license can be used in many locations but has not been used (prior to the current invention) to identify the patron at a game venue. For example, inserting the drivers’ license in a gaming machine would simply not have been successful to identify the patron at the gaming venue.

## *3. The Specification States That The UPI Object Is Not Primarily Used To Identifying The Patron At A Particular Game Venue*

The specification provides numerous examples for supporting the rejected claim term. These examples, such as the credit card and drivers’ license examples, are acknowledged by the

office action. However, the office action alleges that “the object’s primary purpose is changed” when “using these items within a gaming environment.” Once again, this type of logic is flawed.

The office action seems to shift the reference point for defining the term “primary” to simply self-servingly support the rejection. The problem with this type of shifting argument is that it simply disregards the full claim term, take it the term “primary” out of context. The claim term is directed to “a universal personal identifier object (UPI object) in a form of a tangible object whose primary purpose is not directed to identifying the patron at a particular game venue.” The plain meaning of the term “primary purpose” is simply directed to the UPI object in general. The claim does not limit the claim term to a “primary purpose” in one context, and a “primary purpose” in another context.

There is no change in primary purpose. For example, the driver’s license primary purpose does not change when used as a tangible object for identifying the patron at a gaming venue. The primary purpose – for driving privileges – remains the same. What is being added is another purpose (e.g., a secondary or non-primary purpose) for identifying the patron at the gaming venue.

#### *4. The Specification Discloses Different Embodiments of the UPI Object As Claimed In The Rejected Dependent Claims*

The office action alleges that the specification fails to disclose the UPI object “in the form of a memory stick, Bluetooth mobile phone, or Bluetooth mobile device.” The specification discloses at least the following:

[0029] Further, each of the gaming machines 22 and the POS terminals 32 may be configured with a Bluetooth™ module 215 (see, FIGS. 3 and 4) to enable personal identification of a patron via short range wireless communication. For example, using a Bluetooth™ mobile telephone at the gaming machine 22 or POS terminal 32, the patron can identify

himself/herself to the server-based gaming system 10 via a unique 48-bit number associated with the unique patron identification transmitted from the Bluetooth™ mobile telephone. Subsequent patron accounting data generated via game play or spending activity can then be collected and used to reward the patron accordingly.

(emphasis added). The specification further discloses the following:

[0027] Each of the gaming machines 22 and the POS terminals 32 include a card reader 124 (described in detail in connection with FIG. 2) capable of reading one or more types of suitable universal personal identifier cards (e.g., magnetic cards, optical cards, bar coded cards, and memory cards including compact flash cards, memory sticks, smart cards, radio frequency (RF) cards, combination smart cards, hybrid cards, etc.).

(emphasis added). The above-cited paragraphs, and other paragraphs, clearly disclose the matter claimed in the rejected dependent claims.

## **II. § 103 Rejections**

Claims 1-9, 11-23, 25-46, 48, and 50 have been rejected under 35 U.S.C. § 103(a) for allegedly being unpatentable over U.S. Patent No. 6,908,387 to Hedrick *et al.* (“Hedrick”) in view of U.S. Patent Application Publication No. 2003/0045354 to Giobbi (“Giobbi”). Claims 10, 24, and 47 have been rejected under 35 U.S.C. § 103(a) for allegedly being unpatentable over Hedrick in view of Giobbi as applied to claims 1, 15, and 38 above, and further in view of U.K. Patent Application No. 2 363 950 to Kermode.

### ***A. Claims 1, 15, and 38***

Claims 1, 15, and 38 are directed to a universal personal identifier object (UPI object) “in a form of a tangible object whose primary purpose is not directed to identifying the patron at a particular game venue.” The cited references fail to disclose this claim element.

In fact, the office action acknowledges that Hedrick “fails to specifically teach the universal personal identifier object is in a form of a tangible object whose primary purpose is not directed to identifying the patron at a particular game.” However, the office action alleges that “the primary purpose of how the UPI object is used is not claimed” because the “claimed invention is based on the features that are claimed.” Thus, the office action simply chooses to ignore a claim element. This is improper.

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” MPEP, § 2143.03, p. 2100-142 (right col.); *citing In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970) (emphasis added). This basic principle of the patent rules cannot be ignored, for example, when the prior art does not disclose “all words in a claim” (*i.e.*, a particular claim element).

The claim language is directed to a tangible object. However, the tangible object is not any tangible object. The claim language clarifies that the claimed tangible object is one that has a primary purpose that is not directed to identifying the patron at a particular game venue. The clarification distinguishes between any random object (*e.g.*, a tree, a sword, a boat, *etc.*) and the claimed object (*e.g.*, a driver’s license, a credit card, *etc.*). Furthermore, as implicitly acknowledged by the office action, the clarification clearly distinguishes these claims from the cited art. In response to failure of finding disclosure for this claim element in prior art searches (including the cited art of record), the office action appears to unfairly resort to improperly ignoring the claim element at issue.

It is indisputable that the cited references fail to disclose the claim element. The office action specifically acknowledges that Hedrick’s player tracking unit 107 has nothing to do with the claimed UPI object. Similarly, Giobbi does not disclose the claim element. Giobbi’s



portable data unit 14 is a unit that is acquired on site from a gaming establishment, with the primary purpose being to identify the player at the gaming establishment.

Furthermore, in the “Response to Arguments” section, the office action incorrectly concludes that “the claimed invention is directed to a player tracking device in which a player tracking unit [is] carried by a player, and the player tracking unit can be used by multiple gaming sites.” Based on the current specification, and as previously explained, it should be clear that one aspect of the claimed invention is directed to removing the necessity for having a player carry a “player tracking unit” to multiple gaming sites. The claimed UPI object is not a typical player tracking card. Instead, it is an object that is likely to be carried by the player for other (primary) reasons, *e.g.*, a credit card for financial reasons, a driver’s license for driving reasons, *etc.*

Thus, the Applicants respectfully submit that claims 1, 15, and 38, along with all the claims dependent therefrom, are patentable over Hedrick in view of Giobbi.

#### ***B. Claim 29***

Claim 29 is directed to “a Bluetooth™ portable device having a primary purpose that is different than for identifying the patron at a particular game venue.” At least based on the reasons discussed above in reference to claims 1, 15, and 38, as applicable, claim 29 (along with all the claims dependent therefrom) is not obvious in view of the cited references.

### **III. Conclusion**

It is the Applicants' belief that all the pending claims are now in condition for allowance, and thus reconsideration of this application is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

It is believed that no fees are due; however, should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Nixon Peabody LLP Deposit Account No. 50-4181, Order No. 247079-000248USPT.

Respectfully submitted,

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